

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ramon Tam
Serial No.: 10/800,293
Conf. No.: 8247
Filed: 3/12/2004
For: A COLLAPSIBLE ROLLING
SUPPORT STAND
Art Unit: 3632
Examiner: Marsh, Steven M.

**APPELLANT'S REPLY BRIEF ON APPEAL
PURSUANT TO 37 CFR § 41.41**

Appellant contends that the examiner has not properly applied the law of anticipation in the rejections of the claims under 35 U.S.C. 102(b) based upon either Gress or Cunningham.

An invention is anticipated if the same device, including *all* the claim limitations, is shown in a single prior art reference. **Every element of the claimed**

invention must be literally present, arranged as in the claims in question. *Scripps Clinic and Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). The *identical* invention must be shown by the prior art reference in as much detail as is contained in the patent claim. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1267 (Fed. Cir. 1991); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985).

In addition, a recent decision of the Federal Circuit imposes additional requirements for the analysis. In *Net MoneyIN, Inc. v. VeriSign, Inc.*, __ F.3d __ (Fed. Cir. 2008)(Linn, J.), distinguishing *Glaxo Group Ltd. v. Apotex, Inc.*, 376 F.3d 1339, 1348 (Fed.Cir.2004), the Court held that the test for anticipation by a single reference under 35 USC § 102 **requires that a single reference not only disclose all elements of the invention, but that the elements be “arranged or combined in the same way as in the claim.”**

The Court explains: “[A]rranged as in the claim’ is readily understood in relation to claims drawn to things such as ingredients mixed in some claimed order. In such instances, a reference that discloses all of the claimed ingredients, but not in the order claimed, would not anticipate, because the reference would be missing any disclosure of the limitations of the claimed invention ‘arranged as in the claim.’ But the ‘arranged as in the claim’ requirement is not limited to such a narrow set of “order of limitations” claims. **Rather, our precedent informs that the ‘arranged as in the**

claim’ requirement applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. The test is thus more accurately understood to mean ‘arranged or combined in the same way as in the claim.’”

In addition to the arguments presented in Appellant’s appeal brief which sets forth in detail the reasons why the Gress patent fails to show all of the limitations of the claims, Appellant now replies to the Examiner’s Response to Appellant’s arguments.

The Examiner cites *in re Hario* and *Kropa v. Robie*, both of which are ancient CCPA decisions of 1976 and 1951, respectively, for the proposition that the object set forth in the preamble of claim 1 is not accorded “any patentable weight, for it merely recites the process of the intended use of the structure and/or the body of the claim does not depend on the preamble for completeness, but instead, the process steps or structural limitations are able to stand alone.”

Appellants submit that the law relating to this issue is more appropriately found in the decisions of the Court of Appeals for the Federal Circuit which are believed to be accurately set forth in the following paragraphs.

In *Eaton Corp. v. Rockwell Intern. Corp.* 323 F.3d 1332 C.A.Fed. (Del.),2003, the Court set forth the correct law regarding patentable weight to be given to the language of a preamble:

“In general, a preamble limits the [claimed] invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to

the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed.Cir.2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed.Cir.1999)). “[A] claim preamble has the import that the claim as a whole suggests for it. **In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.”** *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed.Cir.1995). When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. See, e.g., *Electro Sci. Indus. v. Dynamic Details, Inc.*, 307 F.3d 1343, 1348, 64 USPQ2d 1781, 1783 (Fed.Cir.2002); *Rapoport v. Dement*, 254 F.3d 1053, 1059, 59 USPQ2d 1215, 1219 (Fed.Cir.2001); *Pitney Bowes*, 182 F.3d at 1306, 51 USPQ2d at 1166.

Clearly, the preamble of the collapsible rolling stand of claim 1 describes the rolling stand, giving detailed recitations of its configuration and operability, particularly with regard to the language “said stand being supported by a ground surface and having a front end portion and a rear end portion, and being capable of being manipulated between open and closed positions, wherein the object is generally vertically oriented when the stand is closed, and where the object is generally horizontally oriented when the stand is in its open position.” The body of the claim then includes a top frame as recited, as well as a folding mechanism as recited, which includes “**said first and second members being pivotally connected to one another and configured so that the**

weight of the object provides a substantial portion of the necessary force needed to pivot said first and second pairs of members to further separate said forward contact point from said rear wheels and move said stand from said closed position to said open position wherein said top frame planar position is substantially horizontal.” Clearly, Gress does not have this recited structure and functionality. Also, the object set forth in the preamble is interrelated with the folding mechanism as claimed because it is “...the weight of the object that provides a substantial portion of the necessary force ...”. As stated in the *Communication Research* case cited above, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined and not some other is the one the patent protects.

It should be apparent that Appellant’s claims are intended to define a collapsible rolling stand and that claim 1 is intended to protect the stand regardless of the type of object that is attached to it. It is certainly within the contemplation of the claim that the collapsible rolling stand would be used with an elongated normally horizontally oriented object, such as a portable saw. This claim believed to be no different in format than the independent Gress claims, claim 1 of which is directed to “a folding stand for supporting and transporting a power driven threaded machine relative to an underlying surface.”

The Examiner also mischaracterizes the Gress reference by stating that the stand taught by Gress is capable of supporting an object and the object can also be adjusted to a vertical position. None of the drawings of Gress support this statement.

Figures 1 & 2 show the stand in its opened position and Figure 3 shows it in its closed position with Figure 4 showing it in its closed and inclined position. When the Gress stand is moved from its open position to its closed position, it is moved from its position shown in Fig. 2 to its position shown in Fig. 3 and Fig. 3 is certainly not in a vertical position. Therefore Gress simply does not anticipate, teach or suggest this claim because claim 1 requires “said top frame planar portion being oriented in a generally horizontal position when said stand is in its open position and a generally vertical position when said stand is moved to its closed position.” Also, it should be noted that the body of claim 1 defines the orientation of the **top frame planar portion** rather than the **object** orientation.

The Examiner contends that the Gress stand shown in Fig. 4 is “generally vertical.” This is believed to be a major distortion of the reference because it is oriented at an approximately 45-degree angle which cannot be objectively considered to be “generally vertical”, particularly in light of Appellants drawings as shown in Figs. 1 & 2. In fact, the Gress reference itself contradicts the Examiner’s characterization. In Column 8, Line 67 through Column 9, Line 8, it clearly indicates that “when the stand is folded and then pivoted to an inclined disposition as described here and above to facilitate rolling movement of the stand and machine relative to surface S, the stand can be further tilted or **inclined** for projections 80 to engage surface S. Nowhere in Gress is there characterization that this is a generally vertical position. The fact that it is raised to an approximate 45-degree angle would not be considered generally vertical to one of ordinary skill in the art or to anyone with a common sense understanding.

The Examiner's rejection on claim 1 based upon Cunningham is equally flawed because when it is moved from its open position to its closed position, it moves from its configuration and position shown in Fig. 3 to that shown in Fig. 4. The orientation of the top frame 14 is absolutely the same and therefore it cannot be deemed to anticipate either the top frame element of claim 1 or the folding mechanism of the claim. It is submitted that it is totally irrelevant that Cunningham is capable of a generally vertical orientation **when the stand is lifted onto its wheels in a generally vertical position**. It would not be stable in such an orientation, and ignores the language of the claim.

The arguments that have been made with regard to claim 1 are believed to apply to the other independent claims.

CONCLUSION¹

The dependent claims not specifically addressed necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and also should be allowed.

¹ A stand is currently being marketed by the Robert Bosch Corporation in combination with a table saw and is referred to as the Gravity-Rise Stand. A glowing review can be read at the following website: <http://www.newwoodworker.com/reviews/bt2000rvu.html>.

For the forgoing reasons, it is respectfully requested that the rejections by the Examiner of the claims on appeal be reversed and added to the previously allowed claims in this application.

Respectfully submitted,

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